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Paper No.

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In re Application of  
Douglas et al.  
Application No. 09/051,939  
Filed: October 16, 1998  
Attorney Docket No. 11375

In re Application of  
Douglas et al.  
Application No. 09/819,097  
Filed: March 5, 2001  
For: Cytokines and Their Use in  
Treatment and/or Prophylaxis of  
Breast Cancer

**COPY MAILED**

**JUL 20 2001**

**OFFICE OF PETITIONS  
A/C PATENTS**

DECISION GRANTING  
PETITION

This is a decision on petition under 37 CFR § 1.53(e) filed May 23, 2001, requesting that an improper Continued Prosecution Application (CPA) under 37 CFR § 1.53(d) be treated as an application under 37 CFR § 1.53(b) and be accorded a filing date of March 5, 2001.

On September 5, 2000, a nonfinal Office action was mailed in application No. 09/051,939, which set a three (3) month shortened statutory period for reply. In response, a petition for a three (3) month extension of time and a request for a CPA under 37 CFR § 1.53(d) based on prior application No. 09/051,939 were deposited on March 5, 2001. However, CPA practice no longer applies to applications, other than design applications, if the prior application was filed on or after May 29, 2000.<sup>1</sup> Accordingly, the CPA request was improper because the prior application was filed on or after May 29, 2000.

<sup>1</sup>An earlier CPA was filed in application No. 09/051,939 on June 22, 2000. Thus, 37 CFR 1.53(d)(1)(i) does not permit the filing of a further CPA.

In the event that an applicant files a request for a CPA of a utility or plant application that was filed on or after May 29, 2000 (to which CPA practice no longer applies), the Office will automatically treat the improper CPA as a request for continued examination of the prior application (identified in the request for CPA) under new 37 CFR § 1.114.

On March 22, 2001, a Notice of Improper Request For Continued Examination (RCE) was mailed, stating that the RCE was improper because continued examination under 37 CFR § 1.114 does not apply to an application unless prosecution in the application is closed. The Notice further indicated that if the RCE was not accompanied by a reply, the time period set forth in the last Office action continues to run from the mailing date of the action. Because applicants did not submit a reply to the nonfinal Office action with the RCE, the application became abandoned on March 6, 2001. A Notice of Abandonment was mailed on May 21, 2001.

On May 23, 2001, applicants filed the present petition under 37 CFR § 1.53(e). Applicants indicated that they did not want the request for a CPA to be treated as a request for continued examination under 37 CFR § 1.114. Rather, applicants requested that the improper CPA be converted to an application under 37 CFR § 1.53(b). With the present petition, applicants submitted a complete copy of the prior application as originally filed, a copy of an executed declaration, and a preliminary amendment.

The petition is granted.

The application under 37 CFR 1.53(b) filed on March 5, 2001, has been assigned application No. 09/819,097. The CPA request, the present petition, the copy of the application as originally filed, the executed declaration, and the preliminary amendment have been removed from the file of application No. 09/051,939 and have been placed in application No. 09/819,097. A copy of the CPA request and the present petition will be retained in application No. 09/051,939 to complete the record therein. All further correspondence concerning the application under 37 CFR 1.53(b) should be directed to application No. 09/819,097, not application No. 09/051,939.

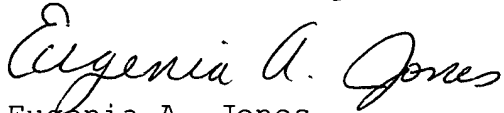
The Office finance records will be corrected to show that the \$710.00 filing fee and the additional claim fees totaling \$522.00, paid on March 5, 2001, were paid in application No. 09/819,097, not in application No. 09/051,939. The \$130.00

petition fee and the \$130.00 fee for expedited treatment of the petition will be charged to counsel's Deposit Account No. 19-1013, as authorized in the petition.

Application No. 09/051,939 will be forwarded to Files Repository.

Application No. 09/819,097 will be forwarded to the Office of Initial Patent Examination for further processing as an application filed under 37 CFR 1.53(b), not under 37 CFR 1.53(d), with a filing date of March 5, 2001, using the copy of the original application papers submitted on May 23, 2001.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Christina T. Tartera at (703)306-5589.



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